

Appl. No.: 10/009,453
Response dated November 12, 2003
Reply to Office action of August 13, 2003

Remarks

Favorable consideration and allowance of the instant application is respectfully requested in view of the foregoing amendments to the claims, and the remarks which follow.

Claims 9-10, 12-16, and 18-24 are pending in this application.

Claims 11 and 17 have been cancelled, without prejudice. No new matter is thought to be introduced thereby.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Initially, Applicant would like to note that it is expected that Applicant's fee for filing the Notice of Appeal, dated April 17, 2003, will be refunded to Applicant, due to the Examiner's decision to re-open prosecution based on prior art newly discovered by the Examiner. It is Applicant's position that Applicant should not be financially penalized for the Examiner's error in not initially discovering the newly relied-upon prior art. Applicant therefore respectfully requests an explanation regarding the procedure used for obtaining a refund of fees paid due to Examiner error.

Claims 9, 12-16, and 18-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ansmann et al. (WO 99/11235). This rejection is respectfully traversed for the following reasons.

It is very well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). Applicant respectfully submits that the Ansmann reference fails to anticipate the present invention on the grounds that it fails to disclose an element of the claimed invention, namely, the limitation of claim 11 which admittedly is not disclosed within the

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Ansmann reference. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 11 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ansmann et al., in view of Miles (US 2,456,437). This rejection is respectfully traversed for the following reasons.

The shortcomings associated with the Ansmann invention are as outlined above, i.e., this reference admittedly fails to teach or suggest the presence of a coating surrounding the metal soap nanoparticles. In an effort to overcome this admitted lack of teaching or suggestion, the Examiner once again relies upon the teachings of the Miles reference. Applicant has argued on numerous occasions that the problem associated with Miles' teaching is that it is silent with respect to the potential for using organic materials to coat **inorganic** soap particles such as the claimed **metal** soap particles. The only soap particles referred to by the Miles reference, which are coated with its organic coating material, are sodium soaps of fatty acids. Thus, even a person of ordinary skill in the art having both the Ansmann and Miles references in front of them, would not necessarily be motivated to apply the organic material of the Miles reference onto the metal soaps of the Ansmann reference, since there is no teaching or suggestion that this can be successfully done. Moreover, there is no teaching or suggestion in either reference that the problem addressed by the Miles reference, i.e., elimination of dust particles, is also a problem experienced by metal soaps. Thus, in Applicant's opinion, the use of the organic materials of the Miles reference on the metal soaps of the Ansmann reference is far from obvious.

The Examiner, in turn, has previously argued that because the Miles reference fails to exclude coating inorganic soap particles, but instead refers to soap particles in general, it would thus be *prima facie* obvious to the routineer to want to coat inorganic soap particles as well. Applicant, however, would once again like to state that *prima facie* obviousness needs to be premised upon a teaching or suggestion found **within** a related-

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upon reference. Prima facie obviousness **CANNOT** be based on what a reference **doesn't teach or suggest**. Applicant respectfully submits that prima facie obviousness must be based upon what a prior art reference says, not on what it doesn't say.


It is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an applicant to prove conclusively that the Patent Office is wrong. See, *In re Soli*, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, *In re Wagner et al*, 152 USPQ 552 (CCPA 1967).

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,


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